



THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Hayes, et al.)	Examiner:	Zimmerman
)		
Application No.:	10/662,263)	Art Unit:	2635
)		
Filing Date:	September 15, 2003)	Attny Doc.:	81230.38US4
)		
Title:	Universal Remote Control)		
	System)		

REPLY BRIEF

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P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Appellants hereby submit this Reply to the Examiner's Answer dated March 8, 2006.

This Reply Brief is being filed in triplicate.

The Commissioner is hereby authorized to charge any fee deficiency or credit overpayment to deposit account number 50-2428 in the name of Greenberg Traurig.

Certificate of Mailing: I hereby certify that this correspondence is being deposited with the U.S. Postal Service as First Class mail, postage prepaid, in an envelope addressed to: Mail Stop Appeal Briefs – Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 15th day of March, 2006.

By: Ranni Matar
Ranni Matar

REMARKS

In accordance with 37 CFR §§ 41.41(a)(1) and 41.43(b), Appellants hereby submit this Reply Brief in response to the Examiner's Answer.

In the Appellants' Appeal Brief, it was asserted that neither Pariente nor Renner, whether considered alone or in combination, disclose each and every element set forth in the claims and, furthermore, that Renner fails to have any disclosure which can be said to suggest modifying Pariente to arrive at the exact invention set forth in the claims as is required to maintain a rejection under 35 U.S.C. § 103.

In the Examiner's Answer it was acknowledged that Pariente fails to disclose, teach, or suggest the claimed readable media wherein the readable media has stored thereon access data that is modifiable by a remote control for the purpose of limiting use of code data that is also read from the readable media by the remote control.

In the Examiner's Answer it appears that the Examiner is now acknowledging that the originally cited to passage from Renner, namely Col. 11, lines 30-35, similarly fails to disclose, teach, or suggest, as asserted in the Appellants' Appeal Brief, the claimed readable media wherein the readable media has stored thereon access data that is modifiable by a remote control (or any other device) for the purpose of limiting use of code data that is also read from the readable media by the remote control.

Recognizing that Col. 11, lines 30-35 of Renner fails to contain the disclosure that is required to support a *prima facie* case of obviousness, the Examiner's Answer, for the first time, now cites to Col. 13, lines 30+ of Renner. In this regard, the Examiner's Answer alleges that this newly cited passage from Renner discloses the desirability of a system in which data stored on a card is modified by a device which reads the card for the purpose of limiting use of "other data"

read from the card as is called for in the claims at issue. It is respectfully submitted, however, that Col. 13, lines 30+ of Renner does not, as asserted in the Examiner's Answer on page 5, disclose, teach, or suggest an ICR card that can be programmed to count down the value of access attempts to limit anything, let alone the number of times "other data" can be used from that data card. Col. 13, lines 30+ of Renner merely states that "a transaction counter may be updated on the card to keep track of the total number of transactions." As is evident, nowhere within Col. 13, lines 13+ of Renner is it expressly mentioned that the card is programmed to "count down" anything and, more importantly, nowhere within Col. 13, lines 13+ of Renner is it disclosed, taught, or suggested that the transaction counter is used to "limit" anything, let alone the use of other data that might be stored on that card. Accordingly, since Renner simply fails to expressly disclose that which is missing from Pariente and cannot be said to inherently disclose that which is missing from Pariente, i.e., "make clear that the missing descriptive matter is necessarily present in the thing described and that it would be so recognized by persons of ordinary skill" *Continental Can Co. USA v. Monsanto Co.*, 948 F.3d 1264 (Fed. Cir. 1991), it is respectfully submitted that the rejection of the claims continues to fail in presenting a *prima facie* case of obviousness and must be withdrawn.

It is additionally respectfully submitted that the new reliance upon Col. 13, lines 30+ of Renner reflects the impermissible picking and choosing from a reference only that which will support a given position to the disregard of what that reference fairly teaches in its entirety. In this regard, the Examiner's Answer clearly disregards the fact that first disclosed embodiment of the Renner invention being relied upon (i.e., Col. 11, lines 30-35) pertains to an off-line access control reader used in connection with a parking garage or the like (which has been demonstrated to be deficient as concerns the rejection of the claims) while the second, separately disclosed

embodiment of the Renner invention being relied upon (i.e., Col. 13, lines 30+) pertains to a vending machine reader (which has also been demonstrated to be deficient as concerns the rejection of the claims). Since the Examiner's answer has not explained, as is required, why one of ordinary skill in the art would be motivated to combine these teachings from Renner, which are not only non-analogous to the claimed invention but also to each other, and use these teachings to further modify Pariente, it is respectfully submitted that the rejection of claims could only have been arrived at through the impermissible use of hindsight reasoning, i.e., the use of the disclosure of the Appellants to piece together these unrelated teachings from Renner for the purpose of deprecating the invention claimed. For this still further reason it is respectfully submitted that the rejection of the claims must be withdrawn.

In sum, since neither Pariente nor Renner disclose, describe, teach, or suggest, either expressly or inherently, a card that has stored thereon access data that is modifiable by the reading device, i.e., remote control, for the purpose of limiting use of other data that is also stored on the smart card and read by the reading device as is set forth in the claim, the combination of Pariente and Renner cannot be said to establish a *prima facie* case of obviousness and it is again respectfully submitted that the rejection of claims 1-10 must be withdrawn.

It is further respectfully submitted that, contrary to statements made in the Examiner's Answer, the Appellant has on numerous occasions (i.e., *in every filed response*) requested that the Examiner demonstrate where the cited references disclose, teach, or suggest the elements set forth in any of dependent claims 3-10.

As concerns dependent claims 3-10, it is respectfully submitted that the Examiner's Answer still fails to present a *prima facie* case of obviousness. In this regard, the Examiner's Answer continues to fail to assert that either Pariente or Renner discloses, teaches, or suggests

code data stored on a readable media that is limited in use by means of access data wherein the code data specifically:

1) functions to allow remote control access to limited-access programming as set forth in claim 3 (in this instance the Examiner is ignoring how that the term “limited-access programming” is defined in the specification, e.g., as a pay-per-view type of program which is not a conventionally available program such as “ESPN”);

2) functions to allow timed access to limited-access programming as set forth in claim 4 (in this instance the Examiner continues to ignore the fact that Renner does not disclose that the card *is programmed* with an expiration data but that it is the card reader that is programmed to limit access by merely reading data from the card as discussed in the Appellants’ Appeal Brief);

3) functions to allow a predetermined number of accesses to limited-access programming as set forth in claim 5 (in this instance the Examiner continues to ignore the fact that Renner does not disclose that the card *is programmed* with a number of accesses but that it is the card reader that is programmed to limit access by merely reading data from the card as discussed in the Appellants’ Appeal Brief);

4) functions to enable access to a code stored within the remote control as set forth in claim 7 (in this instance the Examiner is ignoring the fact that the alleged programming of the card with a counting down number, which is not present in Renner in the first instance, is nevertheless not even relevant to enabling access to code data also stored on a card);

5) functions to associate command codes with buttons of the remote control as set forth in claim 8 (in this instance the Examiner simply continues to ignore this claimed element); or

6) functions as data representative of a channel line-up of a broadcast service provider as set forth in claims 9 or 10 (in this instance the Examiner simply continues to ignore this claimed element).

Since the burden of presenting a *prima facie* case of obviousness with respect to any of claims 3-10 has not been met and since neither Pariente nor Renner disclose any of the elements above-noted, the rejection of at least the above-noted claims must be withdrawn.

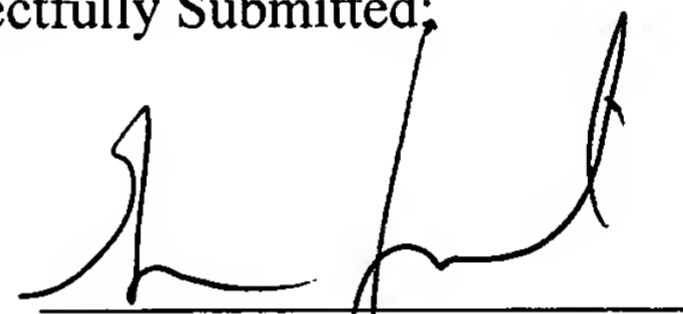
Conclusion

It is respectfully submitted that the application is in good and proper form for allowance. Such action of the part of the Board is respectfully requested.

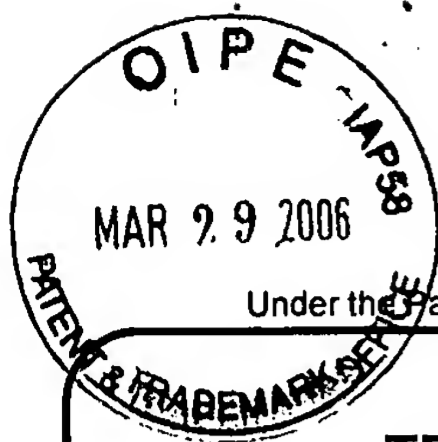
Respectfully Submitted:

Date: March 15, 2006

By:

A handwritten signature in black ink, appearing to read 'Gary R. Jarosik', is written over a horizontal line.

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